

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

In re Ex Parte Application of
ZYXEL COMMUNICATIONS UK
LIMITED ET AL.,
Applicant.

Case No. 19-mc-80175-SVK

**ORDER REQUESTING FURTHER
BRIEFING**

On July 5, 2019, ZyXEL Communications UK Limited and ZyXEL Communications A/S (collectively, “ZyXEL”) filed an *ex parte* application for an order pursuant to 28 U.S.C. § 1782 authorizing service of subpoenas for testimony and documents on Broadcom Inc. and Broadcom Corp. (collectively, “Broadcom”) for use in pending litigation in the United Kingdom. ECF 1. In the underlying litigation, a patent infringement action in the High Court of England and Wales, TQ Delta LLC (“TQ Delta”) asserts that ZyXEL infringes two patents that involve aspects of Digital Subscriber Line (“DSL”) technology, EP (UK) 1 453 268 B I (“the ’268 Patent”) and EP (UK) I 792 430 B9 (“the ’430 Patent”). ECF 2 at 2.

On July 23, 2019, ZyXEL informed the Court that the Court of Appeal in the United Kingdom entered a judgment holding that the RAND declarations sought by TQ Delta “had no real prospect of success.” ECF 9 at 1. As a result, the RAND trial referenced in ZyXEL’s application will not go forward in September 2019. *Id.* ZyXEL argues that its § 1782 application remains viable because the possibility that TQ Delta may appeal the Court of Appeal’s decision means that the English proceeding remains pending. *Id.* at 2. However, on July 24, 2019, the Ninth Circuit vacated and remanded the sole case that ZyXEL relies on to support the continued viability of its § 1782 application. *See Khrapunov v. Prosyankin*, No. 18-16254, 2019 WL

3311231, at *2 (9th Cir. July 24, 2019). In its decision, the Ninth Circuit noted that when the proceeding for which the application initially sought discovery has concluded, “additional fact-finding about the nature of the [foreign] ‘proceeding’ is necessary,” such as the role the discovery sought may play in future proceedings or appeals. *Id.* at 3. Although ZyXEL provides some details through the declaration of Mark Marfé (ECF 8), ZyXEL did not provide the exhibits referenced in the declaration. In light of these developments, the Court finds that further briefing is necessary and **ORDERS** as follows:

- By **July 31, 2019**, ZyXEL shall serve a copy of this order on Broadcom and TQ Delta.
- By **August 15, 2019**, the ZyXEL shall file a supplement brief addressing the following:
 - The impact of the Ninth Circuit’s decision in *Khrapunov v. Prosyankin* on ZyXEL’s application;
 - The role the discovery ZyXEL seeks from Broadcom will play in any future proceedings;
 - The likelihood of those future proceedings occurring.
- By **August 30, 2019**, Broadcom and TQ Delta may chose to file responses to ZyXEL’s § 1782 application or supplemental brief.

SO ORDERED.

Dated: July 25, 2019



SUSAN VAN KEULEN
United States Magistrate Judge